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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/519,979

08/22/2005

Yoshiyuki Ishikura

47233-0050

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EXAMINER

MCINTOSH III, TRAVIS C

ART UNIT

PAPER NUMBER

1623

MAIL DATE

DELIVERY MODE

01/09/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

10/519,979

Applicant(s)

ISHIKURA ET AL.

Examiner

Traviss C. McIntosh

Art Unit

1623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 21 September 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 15 and 16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 9/21/07.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

The Amendment filed 9/21/07 has been received, entered into the record, and carefully considered. The following information provided in the amendment affects the instant application by:

Claims 3, 5, 8, and 10-14 have been amended.

Claims 14-15 have been added

Remarks drawn to rejections of Office Action mailed 3/21/07 include:

Claim objections: which have been overcome by applicant's amendments and have been withdrawn.

112 2<sup>nd</sup> paragraph rejections: which have been overcome by applicant's amendments and have been withdrawn.

102 rejections: which have been maintained for reasons of record.

An action on the merits of claims 1-15 is contained herein below. The text of those sections of Title 35, US Code which are not included in this action can be found in a prior Office action.

#### ***Election/Restrictions***

Newly submitted claims 14-15 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: these claims are drawn to a different statutory class of inventions than those originally filed. There were no methods of use claims present in the previously examined claims.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 14-15 withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-2 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The compounds claimed are naturally occurring compounds produced by oolong tea and the claims do not particularly point out any non-naturally occurring differences between the claimed products and the naturally occurring products. In the absence of the hand of man, the naturally occurring products are considered to non-statutory subject matter. The claims should be amended to indicate the hand of man, e.g. by insertion of the term isolated, as supported by page 2 of the instant specification.

***Claim Rejections - 35 USC § 102***

The rejection of claims 3-7, 10-12, and 14 under 35 U.S.C. 102(b) as being anticipated by Nakahara et al. (US 5,409,692) is maintained for reasons of record. Claims 1-2 are rejected for the same reasons.

Claims 3-7, 10-12, and 14 of the instant application are drawn to various compositions or foods comprising the compounds of claims 1 or 2 as well as methods of making the same.

Claims 1-2 are drawn to various c-glycosides.

Nakahara et al. disclose compositions comprising oolong tea extracts and foods and beverages containing the same (see claim 1). It is noted that while Nakahara et al. does not disclose the identity of the compounds used, it is noted that they obtained their extracts in the same manner as done in the instant application, as such, one of skill in the art would expect that the extract would indeed comprise the compounds instantly claimed. Since the Office does not have the facilities for preparing the claimed materials and comparing them with prior art inventions, the burden is on Applicant to show a novel or unobvious difference between the claimed product and the product of the prior art. See *In re Best*, 562 F.2d 1252, 195 USPQ 430 (CCPA 1977) and *In re Fitzgerald et al.*, 619 F.2d 67, 205 USPQ 594 (CCPA 1980). Moreover, Nakahara et al. would have necessarily included the compounds of the instant application, therefor, they inherently disclose the compounds of claims 1-2.

Applicants argue that the Office has not provided evidence that the food or beverage of Nakahara necessarily comprises a therapeutically effective amount of the compound of claims 1 or 2 and there is only a mere possibility that Nakahara has the properties inherently disclosed therein. However, the examiner has cited *In re Best*, which states that since the Office does not have the facilities for preparing the claimed materials and comparing them with prior art inventions, the burden is on Applicant to show a novel or unobvious difference between the claimed product and the product of the prior art.

The rejection of claims 3-14 under 35 U.S.C. 102(e) as being anticipated by Uehara et al. (US 2002/0136753 A1) is maintained for reasons of record. Claims 1-2 are additionally rejected herein for the same reasons.

Uehara et al. disclose antiallergic composition comprising oolong tea extracts which can be foods, cosmetics, or pharmaceuticals (see abstract, claims 1-16). It is noted that while Uehara et al. does not disclose the identity of the compounds used, it is noted that they obtained their extracts in the same manner as done in the instant application, as such, one of skill in the art would expect that the extract would indeed comprise the compounds instantly claimed. Since the Office does not have the facilities for preparing the claimed materials and comparing them with prior art inventions, the burden is on Applicant to show a novel or unobvious difference between the claimed product and the product of the prior art. See *In re Best*, 562 F.2d 1252, 195 USPQ 430 (CCPA 1977) and *In re Fitzgerald et al.*, 619 F.2d 67, 205 USPQ 594 (CCPA 1980). Uehara et al. would have necessarily included the compounds of the instant application, therefor, they inherently disclose the compounds of claims 1-2.

Applicants argue that the Office has not provided evidence that the food or beverage of Uehara necessarily comprises a therapeutically effective amount of the compound of claims 1 or 2 and there is only a mere possibility that Uehara has the properties inherently disclosed therein. However, the examiner has cited *In re Best*, which states that since the Office does not have the facilities for preparing the claimed materials and comparing them with prior art inventions, the burden is on Applicant to show a novel or unobvious difference between the claimed product and the product of the prior art. The prior art's compositions comprise the same extracts used for the same purposes, one would expect them to comprise the same agents.

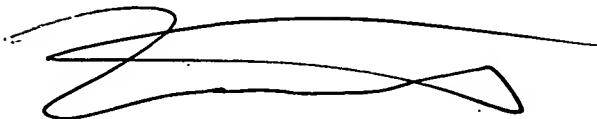
*Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Traviss C. McIntosh whose telephone number is 571-272-0657. The examiner can normally be reached on M-F 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shaojia A. Jiang can be reached on 571-272-0627. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Traviss McIntosh  
January 7, 2008  
Art Unit 1623

A handwritten signature in black ink, appearing to be 'Traviss McIntosh', written over a horizontal line.